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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91162370
Party	Plaintiff De Boulle Diamond & Jewelry, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

DE BOULLE DIAMOND & JEWELRY, INC.,

Opposer,

v.

DE BEERS LV LTD.,

Applicant.

Consolidated Opposition No.: 91162370

Opposition No.'s: 91162370

91162469

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OPPOSER'S (1) REPLY BRIEF TO APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT; (2) RESPONSE IN OPPOSITION TO APPLICANT'S CROSS-MOTION FOR SUMMARY JUDGMENT; AND (3) MOTION TO STRIKE (A) APPLICANT'S EVIDENCE IN RESPONSE AND OPPOSITION TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT AND (B) APPLICANT'S CROSS-MOTION FOR SUMMARY JUDGMENT

Opposer, De Boulle Diamond & Jewelry, Inc. ("Opposer" and/or "De Boulle"), hereby files this Opposer's (1) Reply Brief to Applicant's Response in Opposition to Opposer's Motion for Summary Judgment; (2) Response in Opposition to Applicant's Cross-Motion for Summary Judgment; and (3) Motion to Strike (a) Applicant's Evidence in Response and Opposition to Opposer's Motion for Summary Judgment and (b) Applicant's Cross-Motion for Summary Judgment, filed by Applicant, De Beers LV Ltd. ("Applicant" and/or "De Beers") in this Proceeding, and in support of same will respectfully show<sup>1</sup>:

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<sup>1</sup> This Response is based on (a) the facts, exhibits, and other evidence contained in De Boulle's Motion for Summary Judgment; and (b) The Supplemental Affidavit of Denis J. Boulle in support of Opposer's Motion for Summary Judgment, and attached exhibits, filed simultaneously herewith (the "Supplemental Boulle Affidavit"); all of which, are incorporated herein by reference as if set forth at length for all purposes (the "Summary Judgment Evidence"):

I.

Motion to Strike Cross-Motion for Summary Judgment

1. Applicant has filed a “Cross-Motion for Summary Judgment” (the “Cross-Motion”) with its Opposition to Opposer’s Motion for Summary Judgment (the “Response”). It does not however, have any claims for affirmative relief on file in this proceeding, weather by way of affirmative defense or counter-claim, and there is therefore, no foundation for any affirmative relief sought by Applicant by way of its Cross-Motion. The Cross-Motion should therefore be stricken. *See Fed. R. Civ. Proc.*, Rule 8, 13

II.

Motion to Strike Applicant’s Evidence in Response and Opposition to Opposer’s Motion for Summary Judgment and Cross-Motion for Summary Judgment

2. Applicant has tendered the Declaration of Hamida Belkadi (the “Belkadi Declaration”) in support of the Response and Cross-Motion. The Belkadi Declaration is however, not competent Summary Judgment evidence, in as much as the declaration is almost entirely based on hearsay and/ or constitutes inadmissible expert testimony which the declarant is not competent to make.

3. In this regard, De Boulle objects and accepts to the Belkadi Declaration pursuant to *Fed. R. Civ. Evid.*, Rule 403 and 702, on the following grounds:

(a) The Declarant is the Chief Operating Officer of De Beers Diamond Jewellers U.S. Inc. (“DBDJ”), a United States corporation. *See Belkadi Decl* ¶ 2. Declarant, however, attempts to testify about the structure of a Joint Venture between

entities with whom she is or has not been employed in any capacity, namely, an alleged Joint Venture between a U.K. company, what appears to be a Swiss company, and what is described as a French company, the terms of which the witness has not seen or been a witness or signatory to, and which remains completely unauthenticated, and therefore has no personal knowledge of. *See Belkadi Decl.* ¶ 2

(b) The Declarant further attempts to testify about the same aforementioned apparently Swiss corporation and what the Declarant describes as “the De Beers Group of companies” of which the Declarant likewise clearly has no personal knowledge. *See Belkadi Decl.* ¶ 3

(c) In his regard, the Declarant testifies about events transpiring as early as 1888, 1939, and 1948 at entities with whom she is or has not been employed in any capacity of which the Declarant clearly has no personal knowledge. *See Belkadi Decl.* ¶ 3, 4, 5, 6, Exhibit A.

(d) Furthermore, DBDJ was incorporated on September 22, 2003 in the State of Delaware (and was subsequently authorized to do business in the State of New York on February 19, 2004) and the testimony pertaining to what is described in the Belkadi Decl. as “De Beers” is irrelevant and inadmissible as Summary Judgment evidence, as there is no evidence in the record that either DBDJ or De Beers S.A. and “De Beers” are one or the same, or that DBDJ or De Beers S.A. were assigned any of the rights or privileges of “De Beers” in the prior alleged use by De Beers of its business name. Indeed, neither De Beers S.A. nor “De Beers” is the applicant in his proceeding. *Id*

(e) De Boulle further objects and accepts to Paragraph 9 of the Belkadi Declaration in that the Declarant attempts to express an expert opinion for which the Declarant is not qualified. *See Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S.Ct. 2786, 508 U.S. 579, 589-91 (1993); *Andrew v. Metro North Commuter R. Co.*, 882 F.2d 705, 708 (2d Cir. 1989); *United States v. Jackson*, 425 F.2d 574,576 (D.C. Cir. 1970). De Boulle objects and accepts to the statements in Paragraph 9 in heir entirety for the reason that the Declaration does not state the qualifications, skill or experience of the witness to render such opinions. For example, there is no testimony of the training or expertise of Hamida Belkadi in the jewelry business, how long the Declarant has held her current position, how long the Declarant has been in the jewelry business, the foundation upon which the Declarant bases opinions regarding the attitudes of purchases of fine diamond jewelry expressed in the declaration, etc.

4. The Declaration of Hamida Belkadi should therefore be stricken in its entirety.

### III.

#### The Testimony of Denis J. Boulle is Competent Summary Judgment Evidence

5. Applicant objects to the testimony of Denis J Boulle, on the basis that he is an officer of De Boulle, and therefore allegedly biased, and as to certain opinions expressed by Mr. Boulle.

6. Rule 702 affords court wide latitude to admit expert testimony, and such testimony is inadmissible if it does not meet two related requirements: (1) it must be based on the special knowledge of the expert; and (2) it must be helpful to the finder of fact. *See*

*Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S.Ct. 2786, 508 U.S. 579, 589-91 (1993); *Andrew v. Metro North Commuter R. Co.*, 882 F.2d 705, 708 (2d Cir. 1989); *United States v. Jackson*, 425 F.2d 574,576 (D.C. Cir. 1970)(“To warrant the use of expert testimony ... two elements are required. First, the subject of the inference must be so distinctively related to some science, profession, business or occupation as to be beyond the ken of the average layman, and second, the witness must have such skill, knowledge or experience in that field or calling as to make it appear that his opinion or inference will probably aid the trier in his search for truth”).

7. Under general principles of agency law, knowledge by a corporation's officers or agents is generally attributable to the corporation itself. *BCCI Holdings (Luxembourg), S.A. v. Clifford*, 964 F. Supp. 468, 478 (D.D.C. 1997). In addition, Mr. Boulle has been in the jewelry business of selling and marketing diamonds and fine jewelry to the general public in the United States for more than twenty-five (25) years. *Boulle Affid.*, ¶¶ 4, 5. His skill, knowledge and experience in that field and calling is unchallenged, and he is eminently qualified to testify about the marketing and distribution channels of the jewelry business and consumer perceptions in the field. *See U.S. v. Billings*, *Crim. App. No. 9900122*, United States Court of Appeals for the Armed Forces, June 5, 2005.

8. Furthermore, Mr. Boulle was timely designated as an expert witness in response to discovery in this case. Applicant has had ample opportunity to take Mr. Boulle's deposition and cross-examine the witness. It did not take advantage of the opportunity during the several discovery periods in this proceeding. Furthermore, instead

of exercising its right to file a Motion to Request Discovery, pursuant to Rule 56(f) of Federal Rules of Civil Procedure, after being served with De Boulle's Motion for Summary Judgment, it sought an extension of time with which to respond and therefore, waved its opportunity, yet one more time, to take the deposition of Mr. Boulle<sup>2</sup>.

#### IV.

##### Applicant's Marks are Confusingly Similar to De Boulle's Registered Marks

9. In its response, Applicant contends that as it has added the words "LOGO", "MONOGRAM", "SIGNATURE", "STAR", and "SO" to the "DB" marks at issue in this Proceeding, there can not be any likelihood of confusion with the registered marks owned by De Boulle, namely the mark "DE B<sup>®</sup> and Design" and the word mark DE BOULLE<sup>®</sup>. This premise is incorrect as a matter of law. De Boulle's DE B<sup>®</sup> mark and the DE BOULLE<sup>®</sup> mark are arbitrary with respect to diamonds, timepieces and jewelry. *See McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 202 U.S.P.Q. 81 (2d Cir. 1979); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §§ 12:26 – 12:29 (4<sup>th</sup> ed. 2003) Arbitrary marks, such as De Boulle's DE B<sup>®</sup> mark and the DE BOULLE<sup>®</sup> mark, are often referred to as "strong" marks that are given a broad scope of judicial protection against infringement. *Id.* at §11:4 et seq.

10. The question therefore before the Board is whether Applicant's marks and the registered marks, when viewed in their entirety and consideration given to the dominant portions, are similar in terms of appearance, sound, connotation and commercial

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<sup>2</sup> See TBMP §528.06 (Request for Discovery to Respond to Summary Judgment); *See also* the detailed discussion in *Opposer's Opposition and Response to Applicant's Motion to Request Discovery*, Document No. 43, filed on October 9, 2007, which is hereby incorporated by reference.

impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Adding the words “LOGO”, “MONOGRAM”, “SIGNATURE”, “STAR”, and “SO” to the “DB” does not change the recollection of the purchaser or the overall commercial impression and resulting confusion.

11. Further, if the “dominant” portion of the marks is the same, then confusion may be likely, notwithstanding peripheral differences. *Michelin Tire Corp. v. General Tire & Rubber Co.*, 202 U.S.P.Q. 294 (T.T.A.B. 1979) (the rule of comparing marks in their entireties “is not inviolate”: focus should be on dominant portions). Hence, the marks are similar in appearance, sound and commercial impression as to the “DB” marks at issue in this Proceeding, because the dominant portion of each mark is the same. The dominant portion of the stylized DE B<sup>®</sup> mark is the literary portion “deB,” which will be recognized and remembered as simply “DB,” the phonetic equivalent to “DB”, which is the dominant portion of each of Applicant’s marks in issue in this proceeding. That is, the literal portion “DB” of the respective marks is identical in appearance, sound and meaning in the context of diamonds, timepieces and jewelry. *See Weiss Associates Inc. v. HRL Associates*, 902 F.2d 1246, 14 USPQ2nd 1840 (Fed. Cir. 1990); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975). Customers who are



familiar DeBoulle's DE B<sup>®</sup> mark will confuse the source of goods because of the phonetic equivalence of "deB" and "DB".

12. The respective goods are identical (diamonds, timepieces and jewelry), the channels of trade are the same (retail outlets and web sites), and the purchasers are the same (the general public). In this context, the degree of similarity necessary to support a conclusion of likely confusion declines. *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

13. Furthermore as registered trademarks, the DE B<sup>®</sup> and Design mark and the DE BOULLE<sup>®</sup> mark are presumptively valid. *Igloo Products Corp. v. Brantex, Inc.*, 202 F.3d 814, 53 U.S.P.Q.2d 1753 (5<sup>th</sup> Cir. 2000). In addition, however, De Boulle has provided Applicant with numerous examples of the use of the registered marks in interstate commerce, including web site advertising, in association with sale of diamonds, timepieces and jewelry. *See Boulle Affid.*, ¶ 6, Exhibit K; *Boulle Suppl. Affid.*, ¶¶ 5, 7. In *In Re Dell, Inc.*, 71 U.S.P.Q.2d 1725 (TTAB 2004) (TTAB held web sites qualify as a "display associated with the goods" within the meaning of 37 C.F.R. § 2.56 and 15 U.S.C. § 1127).

## V.

### Applicant's Marks are Confusingly Similar to De Boulle's Common Law "DB" Mark

14. The same analysis holds true for De Boulle's Common Law "DB" mark, which is a combination of letters applied to the sale of diamonds, timepieces and jewelry in such a way that is neither descriptive nor suggestive. An arbitrary mark consists of a word or symbol that is in common usage in the language, but is arbitrarily applied to the goods in question in such a way that it is not descriptive or suggestive. *McCarthy*, §11:4 et

seq. An arbitrary trademark such as DeBoulle's "DB" comes into being as soon as it is affixed to the goods and the goods are sold and it is considered a strong mark. *Blisscraft of Hollywood v. United States Plastics Co.*, 294 F.2d 694, 131 U.S.P.Q. 55 (2d Cir. 1961).

15. DeBeers is attempting to appropriate DeBoulle's common law mark "DB" in its entirety. The addition of other words, such as "SO," "LOGO," "MONOGRAM," "SIGNATURE" and "STAR" does not change the fact that DeBoulle's common law mark has been appropriated in its entirety. Therefore, in the context of diamonds, jewelry, and timepieces, a purchaser who is familiar with DeBoulle's "DB" goods would immediately assume that De Beers' DB LOGO and DB MONOGRAM goods originated with DeBoulle.

16. Moreover, with respect to dominance, one criteria for determining the dominant portion of a composite mark is that if a buyer would be more likely to remember and use one part of a mark as indicating origin of the goods, then this is the dominant portion of the mark. *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 U.S.P.Q. 266 (C.C.P.A. 1955). Adding the words "LOGO", "MONOGRAM", "SIGNATURE", "STAR", and "SO" to the "DB" does not obfuscate the dominant "DB".

17. With arbitrary marks such as DeBoulle's common law mark "DB", priority of user alone is controlling. *Blisscraft* at 694. De Boulle has further provided Applicant with samples, including web site advertising, of its use in interstate commerce since at least as early as 2000 of its DB mark. See Boulle Affid., Paragraph 8; Boulle Suppl. Affid., Paragraph 3, 5, 6, 7. *See In Re Dell, Inc.* above.

18. It is therefore, disingenuous, at best, for Applicant's counsel to assert that there is no evidence of De Boulle's senior use of its DB mark.

VI.

PRAYER

19. De Boule Diamond & Jewelry, Inc., Opposer, prays that, upon consideration of the facts and authorities set forth in its Motion for Summary Judgment on file herein, the Board enter an Order granting its Oppositions in all respects, denying registration of each of the De Beers Marks, and granting it such other and further relief at law and in equity to which Opposer may show itself justly entitled

This the 4th day of February, 2008.

Respectfully submitted,

/Scott Griggs/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that he has served a copy of the foregoing document upon counsel of record by (1) emailing a true copy thereof on this the 4<sup>th</sup> day of February, 2008 and (2) mailing a true copy thereof, through the United States Mail, first class, postage prepaid, on this the 4<sup>th</sup> day of February, 2008, and addressed as follows:

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